

REMARKS

Claims 1, 3 and 4 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 102(e) by *Flickner* (U.S. Pat. Pub. No. 2001/0037512). Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 103(a) by *Sutton* (U.S. Pat. No. 5,968,118) in further view of *Klein* (U.S. Pat. No. 6,637,030). Applicant respectfully traverses these rejections and/or deems them overcome for at least the following reasons. Reconsideration of this application is thus respectfully requested.

Amendment after final

Entry of this Amendment is respectfully requested on the ground that this Amendment places the application in condition for allowance. Alternatively, entry of this Amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

Rejection based on 35 U.S.C. § 112, first paragraph

Claims 1, 3 and 4 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection for at least the following reasons.

Applicant respectfully submits that while the present Office Action denotes that the response filed August 11, 2004 was unpersuasive, it further fails to reject claim 1, 3 and 4 under § 112. In an effort to fully respond to the present action, Applicant has treated this omission as an oversight and responded as if this rejection was enumerated.

Rejections based on the first paragraph of 35 U.S.C. 112 for failing to comply with the written description requirement are appropriate when there is a difference in the definition of the claimed subject matter and the subject matter described in the specification. *In re Higbee*, 527 F.2d 1405 (CCPA 1976). Further, this rejection is appropriate when the claimed subject matter was not described in the specification in such a way as to reasonably convey the invention to one skilled in the art. *MPEP* § 706.03(c).

Applicant respectfully submits that the previous amendments of Claims 1, 3 and 4 satisfy § 112. Support for modulating signals onto a system may be found in the specification at page 15, line 20 through page 16, line 5, wherein the discussion centers around modulating signals before transmission and sending digital information on a RF analog carrier using the same. Further support may be found in the paragraph beginning on page 19, line 6. Applicant thus respectfully submits that modulating signals onto the system is fully supported in the specification.

Further, Claims 2 and 5 are directed, at least in part, to the demodulating of signals in a signal distribution system, while Claims 1, 3 and 4 are directed, at least in part, to modulating, or both modulating and demodulating, signals. In this regard, Applicant respectfully submits that the modulation of signals in a system is taught at least by teaching the demodulation of signals in the same system. One skilled in the pertinent art necessarily receives the knowledge of how to modulate signals from a thorough discussion and understanding of how signals are demodulated. The electrical arts matching modulating and demodulating are not unpredictable arts.

Further, in a previous response Applicant directed the attention of the Examiner to certain portions of the specification for providing support for the amendments made. Applicant respectfully submits that those portions of the specification relied upon do in fact teach the modulating and demodulating of previously presented Claims 1, 3 and 4. Support for the previously presented Amendment may be found in the detailed description at least with respect to the discussion of Figure 3 and in Figure 3.

Accordingly, Applicant respectfully submits that Claims 1, 3 and 4 do meet the requirements of § 112 and particularly meet the requirements of the first paragraph of § 112.

Wherefore, Applicant respectfully submits the requirements of § 112 having been met by Claims 1, 3 and 4, and thus this rejection is overcome. Accordingly, Applicant respectfully requests reconsideration and removal of at least this rejection to Claims 1, 3 and 4.

Rejection based on 35 U.S.C. § 102 (e)

Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 102(e) by *Flickner* (U.S. Pat. Pub. No. 2001/0037512). Applicant respectfully traverses this rejection for at least the following reasons.

Anticipation under 35 U.S.C. § 102 requires the cited art teach every aspect of the claimed invention. See, *M.P.E.P.* §706.02(a). In other words, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See, *M.P.E.P.* §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Rejection with respect to Claim 2

Claim 2 recites, in part,

at least one intelligent device for demodulating single frequency carrier RF signals off of said wideband signal distribution system, wherein said single frequency RF signals comprise IP digital information, said at least one intelligent device including an RF splitter suitable for receiving said modulated single frequency RF signal into at least an IP signal portion and the non-IP RF modulated signal, and at least one demodulator electrically connected to said RF splitter and suitable for demodulating at least the IP signal portion split by said RF splitter.

[Emphasis Added]

Applicant respectfully submits that Flickner fails to teach at least the claimed signal processing with respect to IP digital information. The previous office action cited to paragraph 33 for this teaching. Paragraph 33 in fact sets forth “integrating DOCSIS and Open Cable functionality”. DOCSIS as is known to those possessing an ordinary skill in the pertinent arts as directed to a protocol for the distribution of cable television signals. Cable television signals are not IP (internet protocol) signals. The Open Cable system is directed to cable television and was developed by Cable Television Labs, Inc. Cable television is not distributed using IP signals. The present office action refers to paragraph 29 for this teaching. Paragraph 29 sets forth “Additionally, the head end 16 is operable to provide and/or support bi-directional data communications with the subscribers 20 via what is known as a cable modem, particularly for accessing the Internet.”

The present office action, in light of this citation to paragraph 29, and those actions previously responded to, is obviously utterly failing to recognize the import of the present invention. The invention is not merely the transmission of IP signals. It is, in fact, an invention “wherein said single frequency RF signals comprise IP digital information” and includes a device with “an RF splitter suitable for receiving said modulated single frequency RF signal into at least an IP signal portion and the non-IP RF modulated signal”, and performs a “demodulating at least the IP signal portion split by said RF splitter”. While paragraph 29 at best arguably teaches transmission of IP signals, it clearly fails, even in conjunction with the rest of the Flickner reference, to teach “wherein said single frequency RF signals comprise IP digital information” and having a device with “an RF splitter suitable for receiving said modulated single

frequency RF signal into at least an IP signal portion and the non-IP RF modulated signal", and "demodulating at least the IP signal portion split by said RF splitter". As such, the Flickner system is, in fact, inoperable for the passing of IP signals as taught and claimed in the instant application.

Accordingly, Applicant respectfully submits at least those portions of the Flickner reference cited in this and the previous Office Action fail to teach, or suggest, that an IP signal is distributed modulated in conjunction with a RF signal, for example.

Wherefore, Applicant respectfully submits the cited reference fails to teach or suggest at least each of the limitations of Claim 2, and hence fails to anticipate it. Accordingly, Applicant respectfully requests reconsideration and removal of at least this rejection to Claim 2.

Rejection with respect to Claim 5

Applicant respectfully submits that Claim 5 includes the elements discussed hereinabove with respect to Claim 2. Applicant further respectfully submits that at least those portions of the Flickner reference cited in this and the previous Office Action fail to teach, or suggest, that an IP signal is distributed modulated in conjunction with a RF signal, as set forth with respect to Claim 2.

Wherefore, Applicant respectfully submits the cited reference fails to teach or suggest at least each of the limitations of amended Claim 5, and hence fails to

anticipate it. Accordingly, Applicant respectfully requests reconsideration and removal of at least this rejection to Claim 5 as well.

Rejection based on 35 U.S.C. § 103 (a)

Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 103(a) by *Sutton* (U.S. Pat. No. 5,968,118) in further view of *Klein* (U.S. Pat. No. 6,637,030). Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

Applicant respectfully submits that there is no motivation or teaching to combine the teachings of Sutton and Klein. Further, the combination of the teaching of Sutton and Klein does not render the present invention obvious.

The Examiner correctly recites that the Sutton reference is "silent as to the operation of the modulators and demodulators within the disclosed information outlet." *Office Action at 6*. Applicant respectfully submits that Sutton is designed to accomplish wiring for data communication without modification of the signals. Sutton places the signals for transmission unmodified directly onto the pre-run cables. *See Sutton generally*. The only modification of the signals contemplated or enabled in Sutton is compression, such as by MPEG. *Sutton, Col. 3*. The system of Sutton was designed to free bandwidth, which could arguably allow for modulation onto RF signals but the goals of Sutton are in no way accomplished by, nor does Sutton contemplate or enable, modulating and demodulating. The present office action contends that there is a passing reference to modulators and demodulator within Sutton, but Applicant has found no clear teaching of how such modulation and demodulation occurs.

The present action states that the modulating and demodulating of Klein may be used to "fill the gap" in the teaching of Sutton as to what modulation and demodulation could be used. Applicant respectfully and strongly disagrees, as it is not clear, nor do Klein and Sutton teach in any manner, or even remotely suggest, that the technologies taught in either reference could be used when combined. This is because, simply put,

to accomplish what is claimed in the present invention, Sutton and Klein cannot be combined.

As Applicant has taught, the invention of the present application is not just the modulation of signals on a communication medium; it is, in fact, the modulation/demodulation of signals matched to the communication medium in order to maximize data flow. Applicants submit that this matching of modulation to the communication medium is clearly embodied within the claims. If the Examiner believes that such matching is not clearly set forth in the claims, Applicant would be happy to discuss a claim modification, but the Examiner has set forth, to date, a wholly incorrect combination, and not a lack of claim understanding due to a perceived lack of clarity. As Klein does not match the modulating/demodulating to the medium, and more particularly to the medium of Sutton, since Klein in fact does not teach any relevance to the matching of medium and modulation, the combination of Sutton and Klein does not teach Applicant's invention.

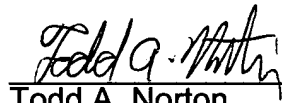
The present office action merely attempts to combine two methods of bandwidth control, but there exists no motivation, suggestion, or teaching to make such a combination nor does the combination, even if improperly made, teach the limitations of the instant claims. In fact, the combination of the teachings of Klein and Sutton would make each redundant, as each intends to accomplish the same goal in different ways. In other words, Sutton accomplishes bandwidth reduction using a series of steps, and one skilled in the art would not be motivated to add unnecessary steps from Klein to obtain the same result that would be obtained by Sutton alone. Such a combination

would thus be inefficient and hence undesirable. As such, Applicant submits there is no motivation to combine Sutton and Klein.

CONCLUSION

In summation, Applicant respectfully submits that all of the claims presently appearing in this application are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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